

REMARKS

Introduction

The above amendments and these remarks are responsive to the Office action mailed on June 22, 2007. Prior to entry of the above amendments, claims 1, 3, 6 and 27–29 were pending in the application, and are rejected in the Office action as anticipated by US20010008849 of Komata, and/or as obvious over a proposed combination of Komata with “Sony Releases PS2 DVD Remote,” an article written by Shahed Ahmed.

In this response, the pending rejections are respectfully traversed. Additionally, claim 1 is amended to clarify the subject matter for which applicant seeks protection, claim 6 is canceled without prejudice, and new claims 30–39 are presented. The claim amendment and new claims are discussed in more detail below, and remarks are presented to demonstrate that the rejections are overcome and that the pending claims are allowable over the cited references of record.

This response is accompanied by a Request for Continued Examination and the appropriate fee, and a petition and fee to extend the period for response to the Office action by three months from September 22, 2007, to December 22, 2007.

In view of the amendments above, and the remarks below, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Claim Amendments, and Interview Summary

Applicant thanks the Examiner for his time on the telephone on December 10, 2007, with applicant’s counsel. In the teleconference, applicant’s counsel requested the Examiner’s suggestions of language to use in a claim amendment to ensure that claimed subject matter relating to the memory storage of the DVD player recited in claim 1 would be considered as a

limitation of the claim, rather than as an intended use, as asserted in the Office action as part of the rejection of claim 6 (see Office action, page 3).

Claim 1 is herein amended to incorporate the Examiner's suggested language, and recites, in part, a DVD and controller for use with a DVD player having a maximum of 1 kilobyte of onboard memory. Claim 1 further recites, in part, that the game scripts utilize a maximum of the 1 kilobyte of onboard memory of the DVD player.

As mentioned in the specification, typical gaming consoles are equipped with large amounts of RAM to hold game information. Conventional DVD players, in contrast, are not equipped with RAM configured for gaming purposes, but to play audio and video content, and therefore include a minimal amount of onboard memory, typically for menuing and viewing features. Applicant's disclosure is directed to DVD media with scripts recorded thereon that are readable by a conventional DVD player to use the available onboard memory to define game variables and thereby control game flow.

Turning now to the other amendments, claim 1 is further amended to clarify that that the game scripts change a value of a game variable as a function of both game input accepted from a controller and the value of the game variable, and to recite that the game scripts control game flow based on the value of one or more game variables. Support for the latter amendment can be found, for example, in Figs. 6 and 7, and in paragraphs [0023], [0029], and [0065].

Additionally, new dependent claims 30–32 are added herein, which depend from claim 1 and recite subject matter that has already been considered in this application, having previously been recited in claims that have been canceled from the application. More particularly, new claims 30 and 31 recite subject matter previously recited in original claims 4 and 13, and new claim 32 recites subject matter previously recited in original claim 9. Because claims 30–32

depend from claim 1, they are believed to be allowable over the references of record for at least the reasons that claim 1 is allowable.

Also, new claims 33–39 are also added herein, which also ultimately depend from claim 1, and recite subject matter supported in the application as filed. For example, the subject matter recited in new claim 33 is supported in paragraph [0027] of the application. New claims 34, 35, and 37 recite subject matter supported in paragraph [0028] of the application. New claim 36 recites subject matter supported in paragraph [0031] of the application. New claim 38 recites subject matter supported in paragraph [0044] of the application, and new claim 39 recites subject matter supported in paragraph [0047] of the application. Because claims 33–39 depend from claim 1, they are believed to be allowable over the references of record for at least the reasons that claim 1 is allowable.

Rejections under 35 USC § 102

Claims 1, 3, 6 and 27–28 are rejected as anticipated by Komata. However, claim 1 is amended herein to recite a DVD and a controller for use with a DVD player having a maximum of 1 kilobyte of onboard memory, and to indicate that the game scripts utilize a maximum of the 1 kilobyte of the onboard memory of the DVD player.

Komata's disclosure is directed to a gaming console (and more particularly to game console controllers that include vibration means), rather than to conventional DVD players having less than 1 kilobyte of onboard memory. The Office action on page 3 acknowledges that Komata fails to disclose that the RAM of the gaming console stores less than 1 kilobyte of data, as previously recited in dependent claim 6. Applicant agrees, and notes that Komata also fails to disclose at least the DVD and controller of amended claim 1, which are configured for use with a

DVD player having a maximum of 1 kilobyte of onboard memory. Komata also fails to disclose game scripts that utilize a maximum of the 1 kilobyte of onboard memory of the DVD player, as recited in amended claim 1. For any of these reasons, Komata therefore fails to anticipate claim 1, and its dependencies.

In the first Office action issued in this application (mailed on November 21, 2006), several claims were rejected as anticipated by US20030190961 of Seidman under 35 USC § 102(e). For example, page 9 of the first Office action asserts a rejection of claim 1, but fails to indicate how the Seidman reference is being used to anticipate some of the subject matter of the claim. More particularly, Figs. 5 and 7, and paragraphs [0072] and [0086] of Seidman are cited in support of the assertion that the claimed subject matter “one or more game scripts operable to define a game variable; associate a value with a game variable defined; and change a value of the game variable as a function of game input accepted from a controller and the value of the game variable” is anticipated. However, although claim 1 is currently not rejected over the Seidman reference, applicant offers these comments for completeness, and notes that neither the cited portions of Seidman, nor the reference as a whole, illustrates or discusses game scripts and game variables. Seidman thus fails to anticipate at least the aforementioned subject matter recited in claim 1, and thus the claims depending therefrom.

Rejections under 35 USC § 103

Claim 29 is rejected as obvious over a proposed combination of the Komata reference with Ahmed, an article directed to announcing the release of a DVD remote control for a Sony PlayStation 2 game console. However, Ahmed fails to cure the deficiencies of the Komata reference to disclose each and every element of claim 1, from which claim 29 depends, as

discussed above. As such, the proposed combination fails to obviate claim 29 for at least the reason that the claim includes subject matter not disclosed in either reference or the combination thereof.

Further, applicant submits that Komata is not a reference that may properly be relied on for the purpose of analyzing the obviousness of the subject matter at issue, because the Komata disclosure, being neither in the field of applicant's endeavor nor reasonably pertinent to the particular problem with which the inventor was concerned, is nonanalogous art.

Although applicant's disclosure and the Komata reference are both directed to electronic gaming, Komata's disclosure relates to a gaming console equipped with a large amount of onboard memory specifically intended to store and process game information, as opposed to a conventional DVD player with limited onboard memory. Because applicant's disclosure is directed to using the limited onboard memory of a conventional DVD player to store game variables to control game flow and provide game play to a user, the field of applicant's endeavor is sufficiently dissimilar from that of the Komata reference, and the problems faced in one field (gaming consoles with large amounts of memory, in Komata) would not be pertinent to an artisan working in another field (conventional DVD players with limited memory, in the instant application), that the Komata reference cannot be considered analogous art.

As noted in MPEP 2141.01(a), the Federal Circuit has recognized that in many disciplines, apparently related references may be considered nonanalogous art for the purposes of determining obviousness under 35 USC § 103. For example, in the electronic arts, an application directed to a single in-line memory module (SIMM) for an industrial controller was found by the court to be in a *different* field of endeavor as a reference directed to SIMMs for installation on a printed circuit motherboard for use in personal computers, because the reference involved

memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories.

Here, because a gaming console with large amounts of memory does not have the same kind of memory constraints as that of a conventional DVD player, it is unlikely that an artisan in one field would consider, or even be aware of, advances in the other field. Applicant notes that the Komata gaming console is disclosed to be operable as a DVD player, but the difference in onboard memory availability between a gaming console and a conventional DVD player is the distinction establishing that the Komata reference and the claimed subject matter are in different fields. As such, Komata cannot properly be relied upon as a reference to establish obviousness of the pending claims.

For somewhat similar reasons, it would not have been obvious to combine the teachings of a reference like Komata, which is directed to a gaming console with large amounts of memory, with that of a reference disclosing use of conventional DVD players, for example, the Seidman reference.


For any of the aforementioned reasons, claim 29, and all of the pending claims, are allowable over the cited references of record, either alone or in combination.

Conclusion

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that a Notice of Allowance be issued that covers the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, he is encouraged contact the undersigned attorney of record.

CERTIFICATE OF E-FILING

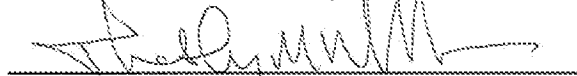
I hereby certify that this correspondence is being transmitted electronically via the United States Patent and Trademark Office's EFS-Web System on December 21, 2007.



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Respectfully submitted,

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